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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,526	09/30/2005	Norbert Steidl	NY-HUBR-1286-US	6204
24972 7590 06/15/2007 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 06/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,526

Applicant(s)

STEIDL ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment of 3/29/07 has been entered. Claims 40-85 are pending.
2. Claims 40-61, 69, and 71-85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims recite molecular weights with regard to the polymeric species (A)(i) without stating whether average molecular weight is intended and if so what type is intended. See a general polymer text for an explanation of this basic polymer concept. It is therefore unclear what type of polymer molecular weight is intended. The applicant's argument that "average molecular weight" would be understood does not overcome the rejection because the type of average molecular weight remains unclear.

B. It is unclear how the polyurethane can be asphalt as required by claim 69 as amended. These are chemically distinct things. Thus it is unclear what is required specifically of claim 69.

C. It is unclear how the compositions of claims 69-72 can simultaneously be all of the things required by these claims as indicated by the use of "and" prior to the last item or no usage of an alternative indicating term such as "or". It is unclear what is required of these claims therefore.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 40-85 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat.

No. 4501852 Markusch et al..

Markusch discloses polyurethane dispersions falling within the scope of those broadly claimed by the instant claims at the abstract; column 2, lines 4-68 which encompasses the instantly claimed polyisocyanates; column 3, lines 1-68, particularly 33-47 et seq. which encompasses the instantly claimed polyol of step b2; column 4, lines 1-68; column 5, lines 1-68, particularly 27-68, which encompasses the instantly claimed amounts of step b3; column 6, lines 1-68; column 7, lines 1-68, particularly 27-35 which falls within the scope of the instantly claimed macromonomer (A)(ii) with its further description at column 7, lines 54-68 and column 8, lines 1-6 and the molecular weight implied by the components and amounts thereof of this disclosure implies the instantly claimed molecular weight and monomodal MW distribution, which is the normal MW distribution for these types of compounds with its subsequent reaction with polyisocyanate falling within the scope of the instantly claimed step b1; column 8, lines 7-68; column 9, lines 1-68, particularly 4-18, 27-33, and 40-41 which discloses using no organic solvents; column 10, lines 1-68, particularly 19-68 which falls within the scope of the instantly claimed step b4; column 11, lines 1-68, particularly 60-68; column 12, lines 1-68, particularly 5-16 which falls within the scope of the instantly claimed step b5, 20-21 and 64-68, which falls within the scope of the instantly claimed step b 6; column 13, lines 1-68; column 14, lines 1-68, particularly 1-12 and 49-68; column 15, lines 1-68, particularly 14-26 which encompasses the instantly claimed amounts of water and particle sizes and 38-55; column 16, lines 1-68; and the remainder of the document. The amounts of ingredients, molar ratios, molecular weights and

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other descriptions of the polyurethane of the patentee are such that the polyurethane of the patentee is expected to necessarily possess moieties falling within the scope and amounts of those of the polyurethane of the instant claims due to the manner in which these polyurethanes can be theoretically divided into numerous types of moieties that would necessarily mathematically fall within the scope of the broadly claimed components and broad amounts thereof. Given the reaction conditions, molar ratios, molecular weights of the reactants used, etc., the polyurethane of the patentee is expected to necessarily possess a molecular weight within the scope of the broad range of the instant claim 61. The dispersion of the patentee is an individual component which falls within the scope of the instant claim 69 as it could be used to coat insulation and finishing necessarily. The dispersion of the patentee could be added to any of the things mentioned in claim 70 and therefore reads on claim 70. It is not seen that the dispersion of the patentee does not take any of the forms of the instant claim 71 and cannot be used to paint a sports floor. The patentee's dispersion therefore falls within the scope of the instant claim 71. It is not seen that the dispersion of the patentee does not take any of the forms of the instant claim 72 and cannot be used coat any of these items. It is not seen that the binder and the fillers of the patentee do not meet the recitation of cement of claim 73. The patentee's dispersions and additives therefore read on the instant claims 72-73. Claims 74-77 are directed to compositions per se and it is not seen that the intended uses define over the compositions of the patentee, which otherwise contain all that is required of these claims. The amounts of column 16, lines 43-47 encompass the instant claim 78.

Claim 70 requires none of the argued limitations regarding the polyurethane as this claim recites no specific composition ingredients. It is not seen that the prior art dispersion cannot function as all of the claimed items.

The applicant's arguments regarding process limitations in the instant claims directed to the products per se are not persuasive because there is not probative evidence that the products of the prior art are not those of the instant claims since they both contain the same moieties and the instantly claimed process steps are not so specific as to exclude the products of the prior art on their face. The prior art polyurethane can be considered to have moieties falling within the scope of the instantly claimed Aii whether used as a starting product or not. column 3, lines 19-22 where said OH terminated prepolymer is prepared with polyether polyol and isocyanates having NCO groups of differing reactivities, as understood by the ordinary skilled artisan, would give the instantly claimed methodology clearly where coupled with the sections cited above. The entire disclosure of Markusch is available as prior art, not only the examples. Not all of the claims require the argued solids content. The arguments of the applicant which are not commensurate in scope with the instant claims and the cited prior art are not persuasive for this reason also. Note column 15, lines 14-16 of the patentee for up to 60% solids. For the reasons clearly stated above and in the full disclosure of the patentee the applicant's arguments are not persuasive over the above rejection.

6. Claims 40-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4501852 Markusch et al..

Markusch discloses polyurethane dispersions falling within the scope of those broadly claimed by the instant claims at the abstract; column 2, lines 4-68 which encompasses the

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instantly claimed polyisocyanates; column 3, lines 1-68, particularly 33-47 et seq. which encompasses the instantly claimed polyol of step b2; column 4, lines 1-68; column 5, lines 1-68, particularly 27-68, which encompasses the instantly claimed amounts of step b3; column 6, lines 1-68; column 7, lines 1-68, particularly 27-35 which falls within the scope of the instantly claimed macromonomer (A)(ii) with its further description at column 7, lines 54-68 and column 8, lines 1-6 and the molecular weight implied by the components and amounts thereof of this disclosure implies the instantly claimed molecular weight and monomodal MW distribution, which is the normal MW distribution for these types of compounds with its subsequent reaction with polyisocyanate falling within the scope of the instantly claimed step b1; column 8, lines 7-68; column 9, lines 1-68, particularly 4-18, 27-33, and 40-41 which discloses using no organic solvents; column 10, lines 1-68, particularly 19-68 which falls within the scope of the instantly claimed step b4; column 11, lines 1-68, particularly 60-68; column 12, lines 1-68, particularly 5-16 which falls within the scope of the instantly claimed step b5, 20-21 and 64-68, which falls within the scope of the instantly claimed step b 6; column 13, lines 1-68; column 14, lines 1-68, particularly 1-12 and 49-68; column 15, lines 1-68, particularly 14-26 which encompasses the instantly claimed amounts of water and particle sizes and 38-55; column 16, lines 1-68; and the remainder of the document. The amounts of ingredients, molar ratios, molecular weights and other descriptions of the polyurethane of the patentee are such that the polyurethane of the patentee is expected to necessarily possess moieties falling within the scope and amounts of those of the polyurethane of the instant claims due to the manner in which these polyurethanes can be theoretically divided into numerous types of moieties that would necessarily mathematically fall within the scope of the broadly claimed components and broad amounts

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thereof. Given the reaction conditions, molar ratios, molecular weights of the reactants used, etc., the polyurethane of the patentee is expected to necessarily possess a molecular weight within the scope of the broad range of the instant claim 61. The dispersion of the patentee is an individual component which falls within the scope of the instant claim 69 as it could be used to coat insulation and finishing necessarily. The dispersion of the patentee could be added to any of the things mentioned in claim 70 and therefore reads on claim 70. It is not seen that the dispersion of the patentee does not take any of the forms of the instant claim 71 and cannot be used to paint a sports floor. The patentee's dispersion therefore falls within the scope of the instant claim 71. It is not seen that the dispersion of the patentee does not take any of the forms of the instant claim 72 and cannot be used coat any of these items. It is not seen that the binder and the fillers of the patentee do not meet the recitation of cement of claim 73. The patentee's dispersions and additives therefore read on the instant claims 72-73. Claims 74-77 are directed to compositions per se and it is not seen that the intended uses define over the compositions of the patentee, which otherwise contain all that is required of these claims. The amounts of column 16, lines 43-47 encompass the instant claim 78.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations and ingredients and amounts thereof and processing steps in making the dispersions because they are encompassed by the patentee and would have been expected to give dispersion and coating properties as described by the patentee.

The applicant's arguments regarding process limitations in the instant claims directed to the products per se are not persuasive because there is not probative evidence that the products of the prior art are not those of the instant claims since they both contain the same moieties and the

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instantly claimed process steps are not so specific as to exclude the products of the prior art on their face. The prior art polyurethane can be considered to have moieties falling within the scope of the instantly claimed Aii whether used as a starting product or not. column 3, lines 19-22 where said OH terminated prepolymer is prepared with polyether polyol and isocyanates having NCO groups of differing reactivities, as understood by the ordinary skilled artisan, would give the instantly claimed methodology clearly where coupled with the sections cited above. The entire disclosure of Markusch is available as prior art, not only the examples. Not all of the claims require the argued solids content. The arguments of the applicant which are not commensurate in scope with the instant claims and the cited prior art are not persuasive for this reason also. Note column 15, lines 14-16 of the patentee for up to 60% solids. For the reasons clearly stated above and in the full disclosure of the patentee the applicant's arguments are not persuasive over the above rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
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